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OFFICE OF PETITIONS

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In re Patent of Montgomery et al.	:	DECISION ON APPLICATION
Patent No. 7,461,024	:	FOR RECONSIDERATION OF
Issue Date: December 2, 2008	:	PATENT TERM ADJUSTMENT
Application No. 09/963,742	:	AND NOTICE OF INTENT TO
Filing Date: September 27, 2001	:	ISSUE CERTIFICATE OF
Attorney Docket No. 35646-175183	:	CORRECTION

This is in response to the "PTA Petition Under 37 C.F.R. §1.705(d)" filed January 30, 2009. Patentees request that the determination of patent term adjustment indicated on the patent be corrected from one thousand two hundred twenty-two (1,222) day to one thousand three hundred forty-two (1,342) days.

The request for reconsideration of the patent term adjustment indicated on the patent is **granted**.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one thousand three hundred forty-two (1,342) days.

Any response to this decision must be submitted within the longer of ONE (1) MONTH or THIRTY (30) DAYS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are NOT permitted.

The application matured into United States Patent No. 7,461,024 with a revised patent term adjustment of 1,222 days on December 2, 2008. This request for reconsideration was timely filed within two months of the issue date of the patent.

The only issue raised by the request is the propriety of the Office's entry of a 120-day reduction under 37 C.F.R. §1.704(c)(10) as a result of a paper filed August 4, 2008.

Background

The application was originally filed with the title, "Buyer-Side Auction Dynamic Pricing Agent, System, Method and Computer Program Product."

On February 1, 2007, patentees filed an amendment to replace the term "Buyer-Side" in the title with the term "Bidder-Side."

The non-final Office action mailed May 1, 2007, did not reference the change to the title or include any reason for patentees to conclude the Office had rejected the request.

A Supplemental Application Data Sheet ("Supplemental ADS") was filed October 12, 2007. The Supplemental ADS indicates the term "Buyer-Side" in the title should be replaced with the term "Bidder-Side."

The final Office action mailed October 18, 2007, did not reference the change to the title or include any reason for patentees to conclude the Office had rejected the request.

The Notice of Allowance mailed May 9, 2008, included the term "Buyer-Side" in the title instead of the term "Bidder-Side."

A "Request to Correct Title" was filed with payment of the issue fee on August 4, 2008. The Request stated,

Please correct the title of the invention in the USPTO data base to reflect the change requested in the Response to Restriction Requirement filed in the USPTO on February 1, 2007. The chance is as follows:

-- ~~BUYER-SIDE~~ BIDDER-SIDE AUCTION DYNAMIC PRICING AGENT,
SYSTEM METHOD AND COMPUTING PROGRAM PRODUCT--.

The Office mailed a corrected filing receipt including the proper title on November 7, 2008.

The Office entered a reduction of 120 days in patent term adjustment as a result of the August 4, 2008 Request to Correct Title.

Opinion

37 C.F.R. § 1.704(c)(10) states,

[Upon] [s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed ... the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months.

M.P.E.P. § 2732 states,

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing

or examination of an application. The submission of amendments (or other papers) after an application is allowed may cause substantial interference with the patent issue process. Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See *Clarification of 37 CFR 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001).

The submission of the following papers after a “Notice of Allowance” is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application:

- (1) Fee(s) Transmittal (PTOL- 85B);
- (2) Power of Attorney;
- (3) Power to Inspect;
- (4) Change of Address;
- (5) Change of Status (small/not small entity status);
- (6) a response to the examiner’s reasons for allowance or a request to correct an error or omission in the “Notice of Allowance” or “Notice of Allowability;” and
- (7) letters related to government interests (e.g., those between NASA and the Office).

Papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include:

- (1) a request for a refund;
- (2) a status letter;
- (3) amendments under 37 CFR 1.312;
- (4) late priority claims;
- (5) a certified copy of a priority document;
- (6) drawings;
- (7) letters related to biologic deposits; and
- (8) oaths or declarations.

The Office has determined the August 4, 2008 Request to Correct Title should not have been treated as a “a failure to engage in reasonable efforts” to conclude processing or examination of an application and should not result in reduction of the patent term adjustment pursuant to 37 CFR 1.704(c)(10).


The request to correct the title was filed after the Office mailed the Notice of Allowance. However, as stated by patentees, “The Notice of Allowance ... was the first reasonable indication that the Patent Office had failed to correct the invention title despite Applicant’s two previous requests.” Therefore, the Office concludes the 120-day reduction for the request to correct the title was not warranted.

Patentees have shown the patent term adjustment should not have been reduced 120 days from 1,342 days to 1,222 days.

Submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand three hundred forty-two (1,342) days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized flourish extending from the end of the name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Draft Certificate of Correction Form

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 7,461,024 B2
ISSUE DATE : December 2, 2008
INVENTOR(S) : Montgomery et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1222 days.

Delete the phrase "by 1222 days" and insert - by 1342 days--